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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,620	02/24/2004	Srikumar N. Chari	MTIPAT.101C1C1	2053
20995	7590	08/30/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			MYERS, PAUL R	
			ART UNIT	PAPER NUMBER
			2112	

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,620

Applicant(s)

CHARI ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/24/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckland et al PN 5,815,647 in view of Culley et al PN 5,943,482.

In regards to claims 1, 4, 8, 14, 16, 27, 29-30, 34-38, 47: Buckland teaches an electronic device, comprising: one or more slots (108, 108a) configured to receive at least one peripheral adapter (5); a software module configured to provide a graphical user interface (containing the icon clicked on by the mouse Column 7 lines 47-67) and one or more hardware modules in the electronic device configured to control the power to the selected slot (105, 105a). Buckland does not teach the GUI indicating whether a selected slot in the electronic device is configured to support a hot insertion function. Culley et al teaches indicating (via a history vector) whether a selected slot in a device is capable of supporting a hot insert function (Column 89 lines 16-30, Column 91 lines 35-46 and Column 92 lines 37-39). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include an indication that the slot can not accept hot insertion in the system of Buckland et al because this would have allowed for preventing using a slot that cannot accept a new device.

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In regards to claims 2, 7, 9-10 and 28: Buckland teaches wherein the electronic device is configured to suspend and resume communication to and from the adapter location in response to a user request to perform the hot insert function Figure 8 step 10.

In regards to claim 3: Buckland teaches the electronic device includes a component for enabling and disabling power to the selected slot (105, 105a).

In regards to claim 5: Buckland teaches a mouse and icon thus a GUI.

In regards to claim 11: Buckland et al teaches initializing a the plug in device (Figure 8 step 9).

In regards to claims 15, 39: Buckland et al teaches user initiated software controlling the card insertion. Buckland does not expressly teach the software being an object oriented environment. Official notice is taken that object oriented graphical user software as evidenced by the windows operating system is well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use object oriented software because this would have allowed for common easy to use software.

In regards to claims 17, 48: Buckland teaches the adapter can be I/O (abstract).

In regards to claims 32, 50: Buckland teaches a hot add function Steps 3-9.

In regards to claims 33, 49: A hot swap is a hot removal followed by a hot add. Buckland teaches a hot removal and a hot add thus a hot swap.

3. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckland et al PN 5,815,647 in view of Culley et al PN 5,943,482 as applied to claim 1 above, and further in view of Hansen PN 5,819,042.

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In regards to claims 6, 12, 18, 21, 24, 31 and 51: Buckland et al only teaches an insertion icon and not what the program associated with the icon displays to the user. Official notice is taken that step by step instructions are common as evidenced by Hansen Figures 4-8. It would have been obvious to include several screens with step by step instructions because this would have allowed for minimally trained personnel to control the insertion/removal of the device(s).

In regards to claim 13: Buckland et al teaches user initiated software controlling the card insertion. Buckland does not expressly teach the software being an object oriented environment. Official notice is taken that object oriented graphical user software as evidenced by the windows operating system is well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use object oriented software because this would have allowed for common easy to use software.

In regards to claims 19, 23 and 26: Buckland teaches the electronic device includes a component for enabling and disabling power to the selected slot (105, 105a).

In regards to claims 20, 22 and 25: Buckland teaches wherein the electronic device is configured to suspend and resume communication to and from the adapter location in response to a user request to perform the hot insert function Figure 8 step 10.

4. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckland et al PN 5,815,647 in view of Culley et al PN 5,943,482 as applied to claim 1 above, and further in view of Touboul PN 6,125,390.

In regards to claim 40: Buckland teaches the hot insertion as described above. Buckland et al does not teach the system being in a server network. Touboul teaches one

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or more server modules in communication with a user interface (the management console), the server network providing information and instructions regarding the status and control of remote peripheral workstations; and one or more communication modules (18) transmitting information and instructions (Set/Get operations) between the user interface using a network management protocol. It would have been obvious to a person of ordinary skill in the art at the time of the invention to allow a system manager, manage insertion and removal of inserted devices because this would have allowed for remote maintenance and removal of unauthorized peripherals

In regards to claim 41: Touboul teaches a server network.

In regards to claim 42: Buckland teaches the electronic device includes a component for enabling and disabling power to the selected slot (105, 105a).

In regards to claim 43: Culley teaches the expansion slots being in expansion boxes 30. The examiner notes the applicants specification describes the canisters as boxes containing the expansion slots.

In regards to claim 44: Culley teaches the canisters having 6 slots 6 slots comprises 4 slots.

In regards to claim 45: Buckland teaches the adapter can be I/O (abstract).

In regards to claim 46: Buckland teaches a slot module (104-106) for each of the slots.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,711,645 and Claims 1-18 of U.S. Patent No. 6,134,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of the current claim language is included in the issued claims of the patents just lacking features already claimed. See *In re Emert* 124 F.3d 1458, 1459, 44 USPO 2d 1 149 (Fed. Cir. 1997).

Conclusion


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL R. MYERS
PRIMARY EXAMINER

PRM
August 24, 2005